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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,388	08/28/2003	Masahiro Morishita	01336D/LH	7167
1933	7590	12/14/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			VINCENT, SEAN E	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			1731	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,388

Applicant(s)

MORISHITA ET AL.

Examiner

Sean E. Vincent

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/874,594.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because of the following informalities: The claim depends from itself. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 3, 4, 6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention
4. Claim 6 is indefinite because it states "The method of claim 5 to 150 times that of the optical glass element to be obtained". It appears to be missing the phrase "wherein the cross-sectional area of said mother glass is" and a number.
5. Claims 3, 4 and 12 are indefinite because they recite "BK7" and other material designations. The designations may have a particular meaning in the art as of today, but their meaning may become lost or changed in the future. More specific glass types or compositions should be claimed. No new matter should be added.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 1, 2 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota (JP 10-001321 – using the machine translation) in view of Snyder (US 5155631).
9. Hirota taught methods of manufacturing optical glass elements including prisms by drawing a preform of the same cross sectional shape as the element and the shapes were disclosed as polygons as well as “round” (see English language abstract, [0007], [0010], [0012] and the figures). Hirota failed to teach specifics of the drawing process such as temperatures and viscosities and drawing rates. Snyder clearly showed that the drawing conditions would vary greatly depending on the type of glass used although it was advised to use the ‘minimum drawing temperature’ (see abstract and col. 6, lines 13-68). It would have been obvious for a person of ordinary skill in the art to draw the preforms of Hirota at the minimum drawing temperature as taught by Snyder because Snyder taught that it was necessary to retain the shape of the preform as closely as possible. It would have been obvious for a person of ordinary skill

Art Unit: 1731

in the art to use the claimed drawing parameters because they were not critical by merely optimal for the material being used (see MPEP 2144.05).

10. Claims 3, 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota in view of Snyder as applied to claim 1 above, and further in view of Imai (US 6067128).

11. Hirota and Snyder do not teach using "BK7" or the other claimed glass types. Imai taught prisms made of BK7 (see col. 10, lines 59-63). It would have been obvious for a person of ordinary skill in the art to incorporate BK7 glass into the process of Hirota and Snyder because Imai clearly showed that miniature prisms were commonly made of BK7.

Conclusion

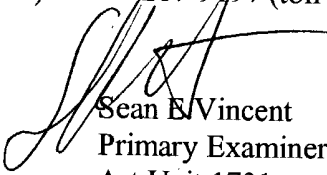
12. The prior art made of record and not relied upon is cited to further show the state of the art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Vincent whose telephone number is (571) 272-1194. The examiner can normally be reached on M - F (8:30 - 6:00).

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S Vincent
December 12, 2004


Sean E. Vincent
Primary Examiner
Art Unit 1731